

S/N 10/033,634

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|             |                                       |                 |              |
|-------------|---------------------------------------|-----------------|--------------|
| Applicant:  | NELSON ET AL.                         | Examiner:       | K. ROWAN     |
| Serial No.: | 10/033,634                            | Group Art Unit: | 3643         |
| Filed:      | DECEMBER 27, 2001                     | Docket No.:     | 163.1118USD1 |
| Title:      | FLY TRAP WITH MULTIPLE LIGHT PATTERNS |                 |              |

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 18, 2005.

By:

Name:

*Kristine A. Wacek*  
*Kristine A. Wacek*

**NOTIFICATION OF LITIGATION**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**23552**

PATENT TRADEMARK OFFICE

Dear Sir:

Applicant hereby informs the US Patent & Trademark Office of one prior merged reexamination proceeding, one current reexamination proceeding, some prior litigation proceedings and one current litigation proceeding involving the following patents owned by Ecolab Inc. ("Ecolab"), which have the following relationship to the present above-captioned patent application:

1. U.S. Patent No. 5,365,690 ("the '690 patent"), to which the present application claims priority.
2. U.S. Patent No. 5,505,017 ("the '017 patent"), to which the present application also claims priority and which claims priority to the '690 patent, and
3. U.S. Patent No. 6,493,986 ("the '986 patent"), which also claims priority to the '690 patent

These proceedings and their results or current status are described below.

#### Gilbert Suit

In November 1994, Ecolab sued Gilbert Industries, Inc. (“Gilbert”) in the District of Minnesota, Civil Action No. 3-94-1505. The parties settled and a final consent judgment was entered on October 16, 1998. A copy of the final judgment is attached as Attachment A.

#### First Paraclipse Suit, Civil Action No. 8:94CV601

On November 23, 1994, Ecolab sued Paraclipse, Inc. (“Paraclipse”) in the District of Nebraska, Civil Action No. 8:94CV601, for infringement of the ‘690 patent by Paraclipse’s “Insect Inn II” flying insect trap. A copy of the final consent judgment is attached hereto as Attachment B.

#### First Merged Reexamination Proceeding

Paraclipse filed its first request for reexamination of the ‘690 patent on March 30, 1995. Paraclipse’s first request was granted as Reexamination Control No. 90/003,779. On November 15, 1995, the U.S.P.T.O. sua sponte merged the reexamination initiated by Paraclipse with another reexamination (90/003,689) initiated by Gilbert at an earlier date. The merged reexamination of the ‘690 patent resulted in a final notice of intent to issue a Reexamination Certificate for the ‘690 patent mailed January 15, 1998, is attached hereto as Attachment C.

#### Gardner and Orkin Suits

Ecolab sued Gardner Manufacturing Company, Inc. (“Gardner”), in the District of Minnesota, in Civil Action No. 98-2294, dated December 5, 2002. Copies of the two Verdict Forms are attached as Attachment D and E.

During the Gardner suit, it was discovered that Orkin Exterminating Co., Inc. had sold traps made by Gardner. Ecolab filed suit against Orkin and Gardner in Civil Action No. 00-CV-2294 in the District of Minnesota.

After the jury verdict in the Gardner suit, Gardner appealed. After the appeal was filed, a confidential settlement agreement was reached resolving Ecolab's claims against Gardner and Orkin. Related to Gardner, a Revised Final Judgment is attached as Attachment F and the order dismissing the appeal is attached as Attachment G. The Stipulation of Dismissal related to Orkin is attached as Attachment H.

Second Paraclipse Suit, Civil Action No. 8:97CV304

On June 20, 1997, Ecolab brought a second suit against Paraclipse in the District of Nebraska, Civil Action No. 8:97CV304, for infringement of the '690 patent by Paraclipse's Insect Inn IV flying insect trap.

The second suit, Civil Action No. 8:97CV304, resulted in a jury verdict. A copy of the Verdict Form is attached as Attachment I.

On April 3, 2002, the Court of Appeals for the Federal Circuit affirmed-in-part, reversed-in-part and remanded to the District of Nebraska for a new trial. A copy of the Federal Circuit decision in Civil Action No. 8:97CV304 is attached hereto as Attachment J. This Federal Circuit decision was also previously provided with the Request for Reexamination.

On December 17, 2003, the Nebraska court entered an order staying the proceedings in that case pending the outcome of this reexamination. A copy of the Order staying the proceedings is attached as Attachment K.

#### Second Reexamination, Serial No. 90/006,659

Paraclipse filed a second request for an *ex parte* reexamination of the '690 patent on June 5, 2003, a copy of which is attached as Attachment L. That request for reexamination was granted on August 26, 2003, and a copy of that order from the U.S.P.T.O. is attached as Attachment M. The first office action has not yet been issued in the reexamination.

#### Anderson Environmental Suit

Ecolab filed a complaint against Anderson Environmental Systems, Inc. and Andex Company for infringement of the '690 patent in Civil Action No. 0:03CV1160 in the District of Minnesota. The complaint was never served and the case was voluntarily dismissed as shown in the Notice of Voluntary Dismissal attached as Attachment N.

#### PestWest Suit

Ecolab filed a complaint on June 25, 2004 against PestWest Electronics Ltd. and PestWest USA, LLC for infringement of the '690 patent, U.S. Patent No. 5,505,017 ("the '017 patent"), and U.S. Patent No. 6,493,986 ("the '986 patent") in Civil Action No. 04-CV-3049 in the District of Minnesota. A copy of this complaint is attached as Attachment O. The complaint was served on the Defendants and, on December 7, 2004, Defendants filed Defendants' Answer and Counterclaims. In their Counterclaims, Defendants allege that each of the patents in suit is invalid. Defendants also allege that each of the patents in suit is unenforceable due to alleged inequitable conduct. Specifically, Defendants allege that German Patent No. 3,840,440 was known to Plaintiff, was material and non-cumulative prior art, and was not disclosed to the Patent Office during prosecution of the patents in suit. Defendants also allege that inequitable conduct occurred in the prosecution of the '017 patent and the '986 patent on the basis of an alleged failure to notify the Patent Office of related litigation. A copy of Defendants' Answer

and Counterclaims is attached as Attachment P. A copy of Plaintiff's Reply to Defendants' Answer and Counterclaim is attached as Attachment Q.

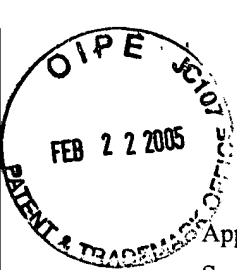
The Examiner is encouraged to contact Ecolab's undersigned representative with any questions or if the Examiner would like to review additional documents or pleadings related to any of the proceedings described above.

Respectfully submitted,

MERCHANT & GOULD P.C.  
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Date: Feb. 18, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: NELSON ET AL. Examiner: K. ROWAN  
Serial No.: 10/033,634 Group Art Unit: 3643  
Filed: DECEMBER 27, 2001 Docket: 163.1118USD1  
Confirmation No.: 9710  
Title: FLY TRAP WITH MULTIPLE LIGHT PATTERNS

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By: Katherine A. Wach  
Name: Katherine A. Wach

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450



Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Check(s) in the amount of \$180.00 for filing Supplemental IDS after receipt of Office Action
- ☒ Notification of Litigation and Attachments A-Q
- ☒ Supplemental Information Disclosure Statement, Form 1449, 82 Reference(s)
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

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